

REMARKS

Claims 1 and 9 to 12 are currently pending.

Reconsideration of the application is respectfully requested based on the following remarks.

With respect to paragraphs 4 to 7 of the Office Action, claims 1 and 9 to 11 were rejected under 35 U.S.C. § 102(b) as anticipated by Fruehling et al., U.S. Patent No. 6,625,688 (the “Fruehling” reference).

Firstly, Applicants respectfully note that the “Fruehling” reference is not valid prior art under 35 U.S.C. § 102(b), which states that a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Thus, to qualify as prior art under 35 U.S.C. § 102(b), a patent must be patented (or published) more than 1 year prior to the date of the application for patent in the U.S. of the rejected application. Regarding the effective filing date of a U.S. patent application, MPEP § 706.02(V) states (emphasis added below):

The effective filing date of a U.S. application may be determined as follows:

...

See MPEP § 1893.03(b) for determining the effective filing date of an application under 35 U.S.C. 371.

Also, MPEP § 1893.03(b) states (emphasis added below):

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application. Specifically, 35 U.S.C. 363 provides that

An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

Thus, a U.S. patent application which is a national stage of an international application under 35 U.S.C. § 371 has an effective U.S. filing date which is its international filing date.

Therefore, because the present application is a national stage application under 35 U.S.C. § 371, its effective filing date is at least as early as its international filing date, i.e., November 5, 2003. By contrast, the “Fruehling” reference has as its an earliest publication date its issue date, i.e., September 23, 2003. Thus, September 23, 2003 is not one year prior to November 5, 2003, and the “Fruehling” reference therefore does not qualify as prior art under 35 U.S.C. § 102(b). For at least this reason, this rejection is considered to be traversed.

Moreover, Applicants respectfully submit that if the Office changes the rejection involving the “Fruehling” reference to be a rejection under 35 U.S.C. § 102(e), it should withdraw the finality of the current rejection under 35 U.S.C. § 102(b) and issuing a non-final Office Action. This is proper because Applicant has successfully traversed the present final rejection without amending the claims.

As further regards the anticipation rejections of claims, to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

To the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Moreover, regarding the level of detail of explanation of the anticipation rejection in the Office Action, MPEP § 706 specifically requires that the “goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Furthermore, MPEP § 707.05 requires that “[d]uring the examination of an application or reexamination of a patent, the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims,” and that when such prior art is cited, its pertinence should be explained.” Finally, MPEP § 707 requires that “when considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included.”

It is respectfully submitted the present Office Action does not explain how the present claims are anticipated by the “Fruehling” reference under 35 U.S.C. § 102(e), since the Office Action merely recites the claim language and then conclusorily asserts that the entire “Fruehling” reference corresponds to the claim language. Citing FIGS. 2, 5, and 6a-6e of the “Fruehling” reference encompasses six pages of the specification, and merely pointing them out does not explain why the claims are anticipated. Applicants therefore respectfully request a proper explanation, as required by the M.P.E.P.

Independent claim 1 reads as follows:

1. *A method for controlling a microcontroller in a control unit in a motor vehicle having a processor core containing at least one read-only memory area, and at least one rewritable memory area, at least one control program that is intended to be processed by the processor core being stored in the rewritable memory area, the method comprising:*
storing a verification program in a write-once memory area of the rewritable memory area;
storing a service program in the read-only memory area;
calling the service program by the control program at regular intervals;
calling the verification program by the service program;
resetting a counter by the service program when called by the control program;
verifying at least part of the rewritable memory area by the verification program;
triggering a reset one of by the verification program in the event of manipulation of the verified memory area and by the counter in the event of counter overflow.

The “Fruehling” reference does not identically disclose (or even suggest) at least the emphasized claim features. Specifically, the “Fruehling” reference does not identically disclose (or even suggest) the feature of storing a verification program in a write-once memory area of the rewritable memory area. As explained above, the Office Action does not explain how the “Fruehling” reference discloses this claim feature. The Office Action only asserts the following (emphasis added below):

ABSTRACT, figures 1-8c and associated descriptions, and more particularly, figures 2, 5, 6a-6e, whereas the determination of the health of a microcontroller used for automotive applications/environments via the use of reference signatures created (and stored as intermediate data structures), processed, and cross-referenced via the single/dual processing elements (i.e., such as the case of the 2nd processor in the dual processor case clearly encompasses a verification program store (write-once memory, EEPROM, etc.) such that the signature are representative of associated memory (i.e., ROM, volatile/non-volatile, etc.) configurations, clearly encompasses the claimed limitations as broadly interpreted by the examiner.

Thus, the Office Action apparently asserts that the 2nd processor in the dual processor configuration of the “Fruehling” reference has a functionality that covers the claimed storing a verification program in a write-once memory area of the rewritable memory area.

However, the secondary CPU (ref. no. 18) of the “Fruehling” reference is not disclosed as having a write-once memory. Furthermore, the “Fruehling” reference does not disclose that the secondary CPU accesses anything that is a write-once memory. For example, the flash/ROM (ref. no. 36), the EEPROM (ref. no. 38) and the RAM (ref. no. 40) depicted in FIG. 1 are not disclosed as write-once memories. Furthermore, the memories and registers of FIG. 2 of the “Fruehling” reference are also not disclosed as write-once memories.

Write-once memories are different than both read-only memories (ROM) and rewritable memories (RAM, EPROM, EEPROM, registers, etc.), as would be understood by one of ordinary skill in the art, and as is explained in detail in the present specification, as follows (emphasis added below).

Write-once-only memory 4 is a password-protected memory area of rewritable memory 5 (flash). (page 5, lines 31-32);

That verification program is stored as code sequence in the write-once-only memory area in the internal flash. The internal flash of the microcontroller has for that purpose an area that is protected by a

password and which therefore may be written to only once. (page 6, line 31, to page 7, line 1)

Thus, write-once memory would be understood by one of ordinary skill in the art, and as described by the specification to be write-once-only memories. Moreover, write-once-only memories are not inherently present in rewritable memory, such as the EEPROM suggested by the Office Action, unless the EEPROM has been specifically designed to include such a memory.

The Office Action, in response to the previous amendment, conclusorily asserts that:

As per applicant's argument concerning the lack of teaching by Fruehling et al of a write-once memory element of a rewritable memory structure utilized for the verification aspects of the claim limitations, the examiner has fully considered in this response to amendment; the arguments, and finds them not to be persuasive.

At the very least, the EEPROM (or flash for that matter) is a memory that upon written to in a programming state is a 'write-once' structure until erased/reprogrammed in a systematic manner, clearly encompassing the 'write-once' as part of a 'rewritable memory' aspects of the claim, as broadly interpreted by the examiner, as per the claim language, and would therefore be applicable in the rejection, such that the rejection support references collectively encompass the said claim limitations in their entirety.

Thus, the Office Action asserts that an EEPROM can be considered to be a write-once memory until it is erased/preprogrammed in a systematic manner. However, there is nothing about erasing/reprogramming an EEPROM in a systematic manner that makes it a write-once memory. For example, all rewritable memories, including RAM, need to be erased/reprogrammed in a systematic manner (i.e., a RAM needs to be rewritten using a certain sequence of signals). One of ordinary skill in the art would clearly understand a RAM to be different than a write-once memory, and would also understand an EEPROM (unless specifically designed to be otherwise) to be different than a write-once memory.

Furthermore, the specification, makes it plain that the write-once memory has a functionality that rises above the level of (e.g., an ordinary un-modified internal flash memory) which mean that it also rises above the level of an ordinary un-modified EEPROM.

The Office Action is unclear as to what it considers to be the write-once memory in the "Fruehling" reference. The Office Action confusingly likened the 2nd processor to the write-once memory and also likens it to an EEPROM to the write-once memory.

Furthermore, it does not appear that any EEPROM disclosed in the “Fruehling” reference actually stores a verification program. Thus, even if (for the sake of argument) the EEPROM of the “Fruehling” reference could be considered to be a write-once memory, the EEPROM is not actually involved in performing the feature of storing a verification program in a write-once memory area of the rewritable memory area, as provided for in the context of the claim.

Further regarding the feature of storing a verification program in a write-once memory area of the rewritable memory area, some of the important benefits of the presently claimed subject matter are as follows. For example, as described in the present specification, “[t]he method according to the present invention offers a number of advantages over known methods. For example, only very low additional costs, if any, arise for the controller chip, since only minimum additional work is required. Furthermore, the verification program may be individually adapted to needs or requirements since this code sequence is not contained in the ROM mask. It may also, therefore, be kept customer-specific. Moreover, the manufacturer of the controller is able to offer that functionality to other customers also.”

Accordingly, claim 1, as presented, as well as its dependent claims, are allowable. It is therefore respectfully requested the anticipation rejections be withdrawn, and because the “Fruehling” reference is not prior art under 35 U.S.C. § 102(b).

With respect to paragraph 8 of the Office Action, claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over the “Fruehling” reference, in view of U.S. Patent No. 6,625,688 to Chetty (the “Chetty” reference).

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claim 12 depends on claim 1, and is therefore also allowable for the reasons explained above, since the secondary reference does not cure the critical deficiencies of the

primary reference. Therefore, withdrawal of this obviousness rejection is respectfully requested.

Accordingly, claims 1 and 9 to 12 are allowable.

CONCLUSION

Applicants respectfully submit that all pending claims of the present application are allowable. It is therefore respectfully requested that the rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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